

Remarks

35 U.S.C. §101 rejections

In the 12 November 2008 Office Action and the May 12, 2010 Examiner's Answer claims 125 - 150 are rejected under 35 USC §101 for allegedly not having a specific utility. The Assignee traverses the claim rejections in a number of ways. First, by noting that the evidence required to support the prima facie case that would sustain the claim rejections has not been provided. MPEP 2164.07 states "the examiner has the initial burden of challenging an asserted utility. Only after the examiner has provided evidence showing that one of ordinary skill in the art would reasonably doubt the asserted utility does the burden shift to the applicant to provide rebuttal evidence sufficient to convince one of ordinary skill in the art of the invention's asserted utility. In *re Brana*, 51 F.3d 1560, 1566, 34 USPQ2d 1436, 1441 (Fed. Cir. 1995) (citing *In re Bundy*, 642 F.2d 430, 433, 209 USPQ 48, 51 (CCPA 1981)). Given the complete absence of evidence to support these assertions, the Assignee submits that the Examiner has failed to establish the required prima facie cause that the rejected claims lack utility. It is also well established that "*an applicant's assertion of utility creates a presumption of utility that will generally be sufficient to satisfy the utility requirement of 35 U.S.C. 101. See, e.g., In re Jolles*, 628 F.2d 1322, 206 USPQ 885 (CCPA 1980); *In re Irons*, 340 F.2d 974, 144 USPQ 351 (CCPA 1965); *In re Langer*, 503 F.2d 1380, 183 USPQ 288 (CCPA 1974); *In re Sichert*, 566 F.2d 1154, 1159, 196 USPQ 209, 212-13 (CCPA 1977)". Second, by noting that there is no statutory basis for the claim rejections as the claim rejections were authored by an Examiner and an organization with a well documented lack of average or ordinary skill in the relevant arts. It is well established patent examination is supposed to be completed "*in light of the specification as it would be interpreted by one of ordinary skill in the art.*" (*In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827 Fed. Cir. 2004, *underline added*). Third, by noting that the claim rejections fail under both standards of the APA. The Assignee also notes that the rejections under 35 U.S.C. § 101 are contrary to the recently issued guidance from the Acting Associate Commissioner for Patent Examination Policy as the claims are all directed to providing concrete results for a real world entity and they all pass the machine or transformation test. Furthermore, claim amendments have obviated these claim rejections.

35 U.S.C. §103 rejections

In the 12 November 2008 Office Action and the May 12, 2010 Examiner's Answer claims 125 - 150 are rejected under 35 U.S.C. §103(a) as being obvious given U.S. Patent 5,812,988 (hereinafter, Sandretto) in view of U.S. Patent 5,361,201 (hereinafter Jost). The Examiner has

cited Sandretto and Jost as references. The Assignee traverses the rejections for obviousness in a number of ways. First, by noting that the claim rejections are not in compliance with the Administrative Procedures Act and are therefore moot. Second, by noting that there is no statutory basis for the claim rejections. The claim rejections are non-statutory because there is no statutory basis for giving any consideration to an obviousness rejection authored by individuals or an organization with a level of skill in the art that is not average or better. Third, by noting that the Office Action has failed to establish a prima facie case of obviousness. In particular, the 12 November 2008 Office Action fails to establish a prima facie case of obviousness for claims 125 – 150 by: citing combinations of documents that teach away from the claimed invention, citing a combination of documents that fails to teach one or more limitation for every claim, failing to explain the combination as required by *KSR v Teleflex*, teaching a combination that requires a change in principle of operation of the disclosed inventions and teaching a combination that would destroy the ability of one or more of the inventions to function. *MPEP 2143.03 provides that: to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art (In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974))*. Furthermore, claim amendments have obviated these claim rejections.

35 U.S.C. § 112 First Paragraph Rejections

In the 12 November 2008 Office Action and the May 12, 2010 Examiner's Answer the Examiner has rejected claims 125 - 150 under 35 U.S.C. §112 first paragraph as lacking a written description that would enable those of average skill in the art to make and use the claimed invention. Specifically, the Examiner has made an unsupported statement that the specification requires subjective judgments and lack a clear set of steps that allegedly would make it difficult to implement the invention. The Assignee traverses the §112 first paragraph rejection of claims 125 - 150 in three ways. First, by noting that the assertions regarding the alleged lack of written description are not in compliance with the both standards of the Administrative Procedures Act and are therefore moot. Second, by noting that there is no statutory basis for the claim rejections. The claim rejections are non-statutory because there is no statutory basis for giving any consideration to a written description rejection authored by individuals and/or an organization with a level of skill in the art that is not average or better. Third, by noting that the Office Action has failed to establish a prima facie case that the specification does not meet the requirements of §112 first paragraph. In particular, the Examiner has failed to establish a prima facie case that the specification does not meet the requirements of §112 first paragraph. *MPEP*

2163 states that: “A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. See, e.g., *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). The examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant’s disclosure a description of the invention defined by the claims. *Wertheim*, 541 F.2d at 263, 191 USPQ at 97. In rejecting a claim, the examiner must set forth express findings of fact regarding the above analysis which support the lack of written description conclusion.

| Summary of 10/743,417 – 1999 priority | Summary of 7,283,982 filed in 2003 |
|---|---|
| 1. Transform raw data into indicators using pre-programmed functions and Linus/AQ algorithms | 1. Use <u>any</u> technique to derive a basic model |
| 2. Develop an initial model using the raw and transformed data as inputs by: <ul style="list-style-type: none"> a) creating parallel models using different specified algorithms, b) using stepwise regression to identify the best set of input variables for the models for each algorithm type | 2. Develop an initial model by: <ul style="list-style-type: none"> a) deriving features from the input to the basic model using <u>any</u> current transform regression algorithm, and b) using stepwise regression to select the input features for the initial regression model |
| 3. Refine the variable selection from 2b) and then transform the resulting set of input variables into summaries using different specified algorithms. Select the best summary using a cross validation algorithm | 3. Complete a non-linear transformation of an explanatory input feature(s) from the initial model. |
| | 4. Use the transformed input features to create a new linear regression model |
| 4. Use the summary of transformed data from 3 to create a plurality of models. Select the best model using a mean squared error algorithm. | 5. Combine the output of the new linear regression model with the output of the initial model and use the sum to provide a final model for the current iteration |
| | 6. Repeat steps 3 through 5 indefinitely |

35 U.S.C. § 112 Second Paragraph Rejections

In the 12 November 2008 Office Action the Examiner has rejected claims 125 - 150 under 35 U.S.C. §112 second paragraph. The Assignee traverses the §112 second paragraph rejection of claims 125 - 150 in three ways. First, by noting that the assertions regarding the alleged lack of written description are not in compliance with the both standards of the Administrative

Procedures Act and are therefore moot. Second, by noting that there is no statutory basis for the claim rejections. The claim rejections are non-statutory because there is no statutory basis for giving any consideration to a written description rejection authored by individuals and/or an organization with a level of skill in the art that is not average or better. Third, by noting that the Office Action has failed to establish a prima facie case that the specification does not meet the requirements of §112 second paragraph. In particular, the Assignee notes that the arguments presented by the Examiner fail to establish the prima facie case required to sustain a §112 second paragraph rejection. *MPEP 2173.02 states that: definiteness of claim language must be analyzed, not in a vacuum, but in light of:*

(A) The content of the particular application disclosure;

(B) The teachings of the prior art; and

(C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent. See, e.g., Solomon v. Kimberly-Clark Corp., 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000). See also In re Larsen, No. 01-1092 (Fed. Cir. May 9, 2001). In the case of claims 125 - 150 the Examiner has failed to establish the prima facie case that the specification does not meet the requirements of §112 second paragraph in at least four ways for every rejected claim. The four ways are:

1. by failing to interpret the claims in light of the specification,
2. by failing to provide any evidence that someone of average skill in the relevant arts would have difficulty interpreting the claims,
3. by failing to establish that the limitation(s) in the claims fail to describe the invention and/or
4. by failing to consider the claim as a whole.

These failures may be due to the fact that those authoring the Office Action do not appear to understand any of the scientific and/or engineering principles applicable to the pertinent art. The detail cited under the discussion of the §112 first paragraph rejection discussion of failure to

comply with the APA also supports the arguments regarding the APA under this section. Furthermore, claim amendments have obviated these claim rejections.

Copending applications

Under the provisions of MPEP § 2001.06(b), the Examiner is hereby advised of information obtained from co-pending U.S. Patent Application(s) which may be "material to patentability" of the instant application (see *Armour & Co. v. Swift & Co.*, 466 F.2d 767, 779, 175 USPQ 70, 79 7th Cir. 1972).

A review of co-pending applications has revealed that the apparently routine allowance and issue of patents to large companies for "inventions" that do not appear to meet the requirements for allowance (i.e. novelty, written description, etc.) appears to be having a material, negative impact on the prosecution of the assignee's patent applications. In accordance with the prevailing statutes, the allowance and issue of patents to large companies for inventions that do not appear to meet the requirements for allowance should not have any impact on the prosecution of Asset Trust patent applications. In fact, the U.S.P.T.O. has a professed commitment and a legal obligation to invalidate patents that do not meet the legal requirements for patentability.

Unfortunately, the U.S.P.T.O. appears to be shielding the patents issued to large companies for "inventions" that do not appear to meet the statutory requirements for allowance instead of honoring their statutory obligation to invalidate them. In particular, the Assignee has recently determined that the primary reasons it has been forced to file over twenty appeals all appear to be related to efforts to bolster patents issued to large companies for inventions that do not appear to be novel. These reasons include:

- 1) the need to traverse apparent misrepresentations that prior art that should properly be used to prevent the allowance of (or invalidate) one or more patents issued to a large company is relevant to an Asset Trust patent application. This is the single largest reason the Assignee has been forced to file so many appeals. For example, one reference used to support claim rejections in co-pending application 10/750,792 was U.S. Patent 6,012,053 (hereinafter, Pant). Pant describes a mechanism through which results from a search query are ranked according to user specified relevance factors to allow the user to control how the search results are presented. In particular, the Pant invention provides the user with the ability to assign weights to different attributes of the search results, generate a score for each item in the results using said weights and then present results ranked according to the score.

A comparison on the key features of Pant to the features of the invention claimed in co-

pending application 10/750,792 and the features of the invention claimed in U.S. Patents 7,212,996 and 7,433,840 shows that Pant appears to be a much closer match to the issued patents than it is to the rejected claims in the instant application.

| Feature | Pant | 7,212,996 & 7,433,840 | 10/750,792 |
|---|--|---|---------------------------------------|
| Primary application | Results from a search query are ranked according to user specified relevance factors | A search application that allows the user to enter a set of criteria of their choice with desired ranges and a weighting factor to be applied to the criteria | Identify impact and value of keywords |
| User defined relevance factors? | Yes | Yes, user defined criteria | No |
| User defined weightings? | Yes | Yes | No |
| Score based on factors and weightings used to sort results? | Yes | Yes | No |
| Keyword financial impact? | No | No | Yes |
| Keyword valuation? | No | No | Yes |

The Examiner for the instant application was an Examiner for the two issued patents and is currently the Examiner for application 10/750,792. Although Pant is well known to those of average skill in the art, the Examiner did not cite Pant during the prosecution of the two issued patents but he did cite it during the prosecution of application 10/750,792. In fact, the Examiner cited Pant in an Office Action for application 10/750,792 on June 17, 2008 and references were still being considered for the application that matured into Patent 7,433,840 on August 15, 2008.

2) the need to traverse apparent misrepresentations that one or more patents issued to a large company for an "invention" that does not appear to meet the requirements for patentability is relevant to an Asset Trust patent application.

3) the need to traverse rejections apparently made without explanation that inventions similar or identical to those found in patents issued to large companies represent non-statutory subject matter.

4) the apparently improper use of Official Notice.

5) the need to traverse rejections apparently made without evidence that methods and/or claims similar or identical to those found in patents issued to large companies are “too subjective” and/or not enabled. This is clearly the case in the instant application, see for example 7,283,982.

6) the need to traverse rejections made for informalities.

7) the need to overcome actions taken by Examiners in apparent violation of one or more statutes, rules or established precedents. These actions appear to be concentrated in Asset Trust applications with pending claims that appear to be similar to those in prima facie invalid patents previously issued to one or more large companies.

For example, the first written description rejection for the co-pending application 09/761,670 was in the second Office Action which had pending claims similar to those in a prima facie invalid patent that had been issued to a large company. The written description rejection was apparently made without evidence (in place of the requisite preponderance of evidence) by an Examiner who does not appear to have the requisite level of skill in the relevant arts after a request to amend the claims in co-pending application 09/761,670 to be more distinct from the language contained in the claims of the prima facie invalid patent was refused. Two of the other written description rejections received by Asset Trust were apparently made without evidence by the same Examiner (who does not appear to have the requisite level of skill in the relevant arts) for applications with claims similar to those in prima facie invalid patents issued to the same large company. Other written description rejections appear to follow this pattern.

The U.S.P.T.O. has issued a number of prima facie invalid patents for the use of xml in data management. The Examiner for an Asset Trust application for an invention that used xml in data management recently imposed a restriction requirement in a final rejection in apparent violation of 37 CFR 1.142. The improper application of this requirement appeared to be an effort to avoid the examination and/or the appeal of claims related to the use of xml in data management that would have made the prima facie invalidity of the issued xml data management patents more obvious. The Examiner for another Asset Trust application imposed a restriction requirement in a final rejection in apparent violation of 37 CFR 1.142 in what appeared to be a similar effort to avoid examination and/or the appeal of claims that

would have made the prima facie invalidity of an issued patent for risk mitigation optimization more obvious.

In the case of co-pending application 09/761,670, the Examiner and the BPAI have to date refused to re-open prosecution in spite of the fact that the Assignee has twice complied the requirements for having prosecution re-opened (the payment of the fee and the provision of an explanation in accordance with the meaning of 37 CFR 1.111 – see MPEP 706.07(h)). As in the other cases outlined above, the apparent violation of the rules appears to be related to the fact that the claims in the re-opened Asset Trust application are now similar to those in a prima facie invalid patent that was previously issued to a large company.

It is not clear why the one or more statutes, rules or established precedents have apparently been violated during the prosecution of Asset Trust patent applications. However, it is clear that any assertion that Asset Trust applications are being examined fairly and/or in accordance with the law is disingenuous at best.

The subject matter contained in the discussion above may be deemed to relate to the present application, and thus may be felt (with or without reasonable justification) to be material to the prosecution of the instant application.

- ☐ Copies of cited U.S. patent application(s) (office actions, specification, claims, and the drawings) or copies of the portion(s) of the application(s) which caused it(them) to be cited, including any claims directed to such portion(s) are attached hereto.
- ☒ Copies of the cited U.S. Patent Application(s) (office actions, specification, claims, and the drawings) and U.S. Patents are available on the U.S.P.T.O.'s Image File Wrapper. Therefore copies thereof need not be attached.
- ☐ The materials in the envelope are considered trade secrets and are being submitted for consideration under MPEP § 724.

The above-listed co-pending application(s) is not to be construed as prior art. By bringing the above-listed application(s) to the attention of the Examiner, the Assignee does NOT waive any confidentiality concerning the above-listed co-pending application(s) or this application. See MPEP §101. Furthermore, if said application(s) should not mature into patents, such application(s) should be preserved in secrecy under the provisions of 35 U.S.C. § 122 and 37 C.F.R. § 1.14.

Acknowledgement

The Assignee previously requested: an unbiased patent application examination conducted by an Examiner with knowledge of the relevant arts who follows the law for the instant application.

The Office's apparent failure to provide such an examination for the instant application is taken as an acknowledgment that no personnel with the requisite level of skill in the art and/or training in the relevant statutes and precedents are available at the present time.

Statement under 37 CFR 1.111

37 CFR 1.111 requires that the basis for amendments to the claims be pointed out after consideration of the references cited or the objections made. The Assignee notes that this requirement is not relevant to the instant application because, as detailed above, there are no references or objections to avoid. Having said that, the Assignee notes that amendments to the independent claims obviate the rejections under 101 and 103 as none of the cited references include a transformation and because the transformation makes it even more clear that the claimed invention passes the machine or transformation test. The amendments to the claims obviate the 112 second paragraph rejections by correcting informalities. Finally, the information from co-pending applications makes it even more clear that all claim rejections are moot as it provides clear documentation that the Examiner and the organization do not appear to have the level of skill in the art required to: interpret claims as required to assess 35 U.S.C. 101 compliance, evaluate prior art as required for a 35 U.S.C. 103 evaluation and/or evaluate a written description under either paragraph 1 or 2 of 35 U.S.C. 112.

Reservation of rights

The Assignee hereby explicitly reserves the right to present the previously modified and/or canceled claims for re-examination in their original format. The cancellation or modification of pending claims to put the instant application in a final form for allowance and issue is not to be construed as a surrender of subject matters covered by the original claims before their cancellation or modification.

Conclusion

The pending claims are of a form and scope for allowance. Prompt notification thereof is requested.

Respectfully submitted,
Asset Trust, Inc.

/B.J. Bennett/

B.J. Bennett, President

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